

### REMARKS/ARGUMENTS

Applicants thank the Examiner for the indication that claims 12, 19-24, 29, and 32-36 would be allowable if rewritten in independent form including all of the intervening limitations.

Claims 1, 12, 18-24, and 26-36 are pending after amendment. Claims 13-15, 17, 25 and 37-38 have been canceled without prejudice or disclaimer.

Applicants respectfully submit that entry of this amendment is proper, because it will greatly reduce the number of issues on appeal.

The rejections to the canceled claims are moot, and therefore will not be addressed.

#### ***Claim 1 Is Not Anticipated Or Rendered Obvious By The Reference***

Claim 1 is now the sole independent claim. Claim 1 stands rejected under either 35 USC 102(b) or 35 USC 103(a) over U.S. Patent No. 4,816,506 to Gamon. Applicants respectfully traverse the rejection, as the Gamon reference neither anticipates or renders obvious Claim 1. In fact, Applicants believe that due to the Gamon reference's inability to teach or suggest all limitations of the claims, no *prima facie* case of anticipation or obviousness can be established, and thus the rejection is improper.

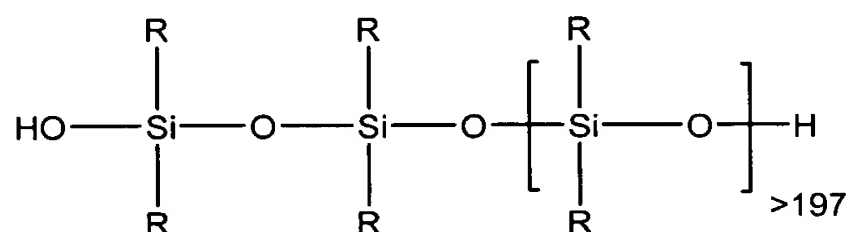
Applicants are concerned that the Office Action's rejection is based on a fundamental misreading of the Gamon reference. The Office Action states "Gamon et al teach an aqueous dispersion comprising polydiorganosiloxanes having hydroxyl groups in the terminal units **which meet the instant polymer ...**" (page 3; emphasis added). As will be shown, the Gamon reference's polydiorganosiloxanes cannot anticipate or render obvious Claim 1. First, the compounds are siloxanes. Moreover, they are limited to "poly-di-organo" compounds.<sup>1</sup>

The cited portion of the Gamon reference is limited to a siloxane. Webster's Dictionary defines siloxane as "any of various compounds **containing alternate silicon and oxygen atoms** in either a linear or cyclic arrangement usually with one or two organic groups attached to each silicon atom." ([www.m-w.com](http://www.m-w.com); 2004; emphasis added). In addition to the

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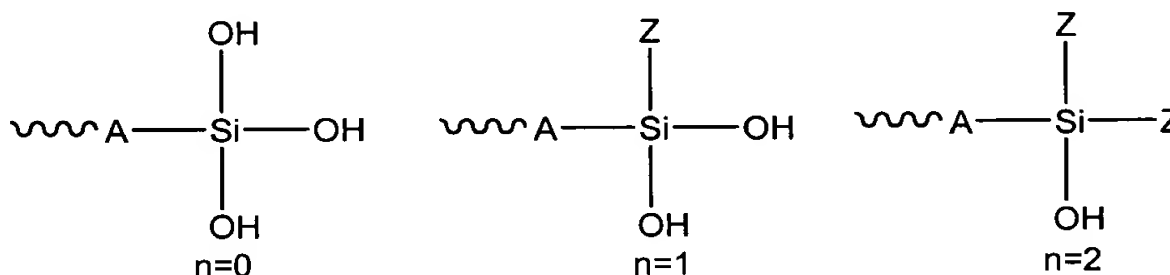
<sup>1</sup> The Gamon reference's polydiorganosiloxanes are poly-di-organo compounds, which requires that each of the silicon atoms, and the Gamon reference requires at least 200, be disubstituted with organic compounds. There is no motivation to change this. In fact, the disclosure teaches away from incorporating mono or tri organic substitutions, as the monosubstituted and trisubstituted varieties are labeled as "more or less unavoidable impurities." (col. 2, lines 3-4; emphasis added).

common meaning of the term, the Gamon reference itself shows that the compound is **limited to repeating units of silicon and oxygen**. The Gamon reference's formula (I) reads  $\text{HO}[-\text{SiR}_2\text{O}]_n\text{H}$ , where  $n$  is an integer of at least 200. (col. 1, lines 55-63). Thus, the Gamon reference's polydiorganosiloxanes have the following structure:



**Gamon reference**

The foregoing structure clearly is not a structure which anticipates Applicants' claimed formula [[I]], which can be graphically represented below when  $n$  is 0, 1 or 2:



**Present invention**

wherein:

A is  $\text{CH}_2$  or is a linear or branched, saturated or unsaturated alkylene radical having from 2 to about 12 carbon atoms or is an arylene radical having from about 6 to about 18 carbon atoms or an arylenealkylene radical having from about 7 to about 19 carbon atoms,

Z is  $\text{CH}_3$ ,  $\text{O-CH}_3$  or is a linear or branched, saturated or unsaturated alkyl radical or alkoxy radical having from 2 to about 12 carbon atoms ...

There are no situations where the Gamon reference's polydiorganosiloxanes can read on the Applicants' claims. To anticipate a claim, a reference must teach every element of the claim. MPEP §2131. Thus, an anticipation rejection is improper.

Likewise, MPEP §2143 requires that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." However, there is no suggestion

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37 CFR § 1.116

or motivation to modify the polydiorganosiloxanes to read on the claims. The Examiner has failed to provide any explanation as to how one skilled in the art would be motivated to modify the reference. Thus, the **alternate silicon and oxygen atoms** of the Gamon reference's polydiorganosiloxanes cannot render Claim 1 obvious.

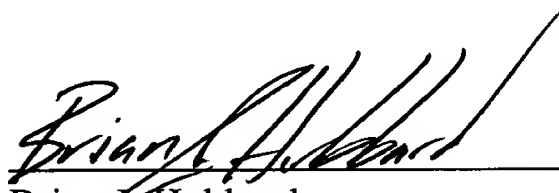
Applicants note that the Gamon reference's siliconates (col. 2, line 64 *et seq.*) cannot anticipate or render obvious Claim 1 either, as, among other reasons, the M portion is limited to "an alkali metal cation or an ammonium or phosphonium group" (col. 3, lines 8-9).

As the Office Action has not cited U.S. Patent No. 4,567,228, U.S. Patent No. 5,760,123, U.S. Patent No. 5,162,420, or U.S. Patent No. 6,313,335 against Claim 1, Applicants assume that Claim 1 is in condition for allowance. Claims 13-15, 17, 25, and 37-38 depend from and further limit the independent claim, and therefore are allowable as well.

If the Examiner has any questions, the Examiner is cordially invited to call the undersigned.

Date:

*Mar 4, 2004*

  
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